



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/489,539	01/21/2000	Helen Viazmensky	DEXNON/096/US	5964
2543	7590	07/01/2005	EXAMINER	
ALIX YALE & RISTAS LLP 750 MAIN STREET SUITE 1400 HARTFORD, CT 06103			SPERTY, ARDEN B	
			ART UNIT	PAPER NUMBER
			1771	

DATE MAILED: 07/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/489,539

Applicant(s)

VIAZMENSKY ET AL.

Examiner

Arden B. Sperty

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11, 12, 14-18 and 20-22 is/are pending in the application.
- 4a) Of the above claim(s) 15 and 22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11, 12, 14, 16-18, 20 and 21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**FINAL OFFICE ACTION**

***Summary***

1. Applicant's remarks, entered 8/16/04, and amended claims, entered 3/07/05, have been carefully considered.
2. Claims 1-9, 11, 12, 14-18, 20-22 are pending. Claims 15 and 22 are withdrawn.
3. Objection to claim 13 is withdrawn per Applicant's amendment.
4. Rejection of claim 9 under 35 USC 112, second paragraph, for being internally inconsistent, is withdrawn per Applicant's remarks. Applicant's remarks explain that the phases or furnishes are provided during the process of making the final product. It is noted that the product of claim 9 is a single layer where the phases or furnishes are distributed homogenously throughout the layer. Since the furnishes are distributed homogenously, the two-phase/furnish process limitations are not seen to distinguish the product from prior art products that may be made from a single phase, or more than two phases.
5. Rejection of claim 12 under 35 USC 112, second paragraph, is withdrawn per Applicant's remarks.
6. Rejection of claim 22 under 35 USC 112, second paragraph, for containing relative, undefined terms, is withdrawn per Applicant's claim amendments.
7. The rejection of the claims as anticipated by or obvious in view of prior art USPN 5292581 to Viazemsky are withdrawn pre Applicant's amendment. Both the 35 USC 102(b) rejection and the 35 USC 103(a) rejection using this reference have been overcome by amendment to the claims to require a non-hydroentangled product.

***Election/Restrictions***

8. Currently amended claim 22 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claim 22 is specifically drawn to an infusion material having seal seam strength, thus having a final structure other than that of a stock material. The previously examined claims are drawn to a stock material. Therefore, the seamed infusion product constitutes an invention that is independent from that which was previously examined.

9. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 22 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

10. This application contains claims 15 and 22, drawn to a nonelected invention. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

***Claim Rejections - 35 USC § 112***

11. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

12. Claims 1-9, 11, 12, 14, 16-18, 20-21, are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to

Art Unit: 1771

reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The negative limitation, requiring a "non-hydroentangled" product, constitutes new matter. New matter must be cancelled from the claims. It is noted that although the prior art rejections of the previous office action are presently overcome by the "non-hydroentangled" requirement, the prior art rejections can be reinstated upon cancellation of this new matter.

13. The newly added negative limitation is also rejected under 35 USC 112, first paragraph because any negative limitation or exclusionary proviso must have basis in the original disclosure. If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims. See *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), *aff'd mem.*, 738 F.2d 453 (Fed. Cir. 1984). The mere absence of a positive recitation is not basis for an exclusion. Therefore, the mere absence of "hydroentangling" from the specification is not basis for excluding hydroentangling.

### ***Claim Rejections - 35 USC § 102***

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

15. Claims 1-3, 5-6, 8-9, 11, 16-18, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 08269888 to Miyata.

16. The Miyata reference teaches a single sheet of composite material comprising 10-50 pts.wt of thermoplastic polyester resin, and 100 pts.wt. cellulose pulp, thus

Art Unit: 1771

anticipating the limitations of claims 1 and 2. Although the reference is silent with respect to the heat-sealing properties of the sheet, when the structural and chemical limitations are met the properties are seen to follow. Therefore, the claim limitations are understood to be anticipated by the teaching of the reference.

17. Claims 3 and 11 are anticipated by the teaching of pulp such as bleached kraft pulp of broad-leaved trees. Regarding claim 11, "long" is a relative term and alone cannot serve to patentably distinguish over the prior art.

18. Claim 5 is anticipated by the structure of the reference before it is treated with a hot plate.

19. Claims 6 and 8 are anticipated by the teaching of a fibrous or powdery polybutylene succinate.

20. Claim 9 does not imply further structural detail to the structure of claim 1. Therefore, the structural details of claim 9 are anticipated by the teaching of the reference wherein a traditional paper-making process is used to form the composite sheet.

21. The process taught by the reference anticipates the process limitations of claim 16. Claims 17, 18 and 20 do not add further process steps, and are therefore anticipated by that which anticipates claim 16.

***Claim Rejections - 35 USC § 102/103***

22. Claims 12 and 14 are rejected under 35 USC 102(b) as anticipated by or, in the alternative, under 35 USC 103(a) as obvious over JP 08269888 to Miyata.

23. Although the reference is silent with respect to the specifically claimed properties, when the structural and chemical limitations are met the properties are seen to follow. Therefore, the claim limitations are understood to be present in the nonwoven of the reference. The burden is on Applicant to prove otherwise. *In re Fitzgerald*, 205 USPQ 594. In the alternative, the presently claimed properties would obviously have been present once the nonwoven was provided. *In re Best*, 195 USPQ 433.

***Claim Rejections - 35 USC § 103***

24. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

25. Claims 4, 7 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 08269888 to Miyata, as applied to claim 1 above.

26. Although the Miyata reference is silent with respect to the basis weight of the sheet material, it would have been obvious for one of ordinary skill in the art to optimize the basis weight according to the ultimate intended use. Thus, absent a showing of unexpected results with the basis weight of claim 4, no patentable distinction is seen in the designation of specific values.

27. Regarding claim 7, it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use. *In re*

*Leshin*, 125 USPQ 416. It would have been obvious to one of ordinary skill in the art to substitute one synthetic pulp for another.

28. Regarding claim 21, since multi-phasic paper making processes are notoriously well-known in the art, such would have been obvious to one of ordinary skill in the art motivated by properties desired in the final product. There is no patentable distinction between the multiphase process of the claim and that which is well-known in the art.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

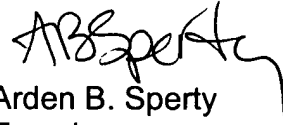
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arden B. Sperty whose telephone number is (571)272-1543. The examiner can normally be reached on M-Th, 08:00-16:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571)272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



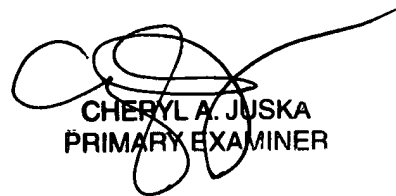
Art Unit: 1771

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Arden B. Sperty  
Examiner  
Art Unit 1771

June 13, 2005



CHERYL A. JUSKA  
PRIMARY EXAMINER